UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,795	03/10/2004	Carlos R. Plata-Salaman	ORT-1575CON	4508

27777 7590 06/11/2008

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER	
LEWIS, AMY A	

ART UNIT	PAPER NUMBER
1614	

MAIL DATE	DELIVERY MODE
06/11/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/797,795	PLATA-SALAMAN ET AL.	
	Examiner	Art Unit	
	Amy A. Lewis	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 March 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21,24,25 and 32* is/are pending in the application.

4a) Of the above claim(s) *22,23 and 26-31* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21, 24, 25, and 32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/9/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election of the species Formula (Ib) S-enantiomer and the neurodegenerative disorder as specifically recited in claim 24 (acute neurodegenerative disorders associated with abrupt insult resulting from hypoxia-ischemia selected from cerebrovascular insufficiency, cerebral ischemia and cerebral infarction) in the reply filed on 3/2/2007 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction/election of species requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 22, 23, and 26-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected subject matter, there being no allowable generic or linking claim.

Claims 1-21, 24, 25, and 32 are examined as far as they read upon the elected species.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-21, 24, 25, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6103759 (to Choi et al.) in view of U.S. Patent No. 5474990 (to Olney).

Choi et al. teach the elected compound (see col. 8, Table I, entry 3). The cited table also teaches a dose of 50.0 mg/Kg. The reference also teaches that the compound can be used for the treatment of diseases of the central nervous system, particularly stroke (see. col. 7, lines 11-15).

While Choi et al. do not teach injury caused by hypoxia-ischemia, Olney teaches that strokes cause hypoxia-ischemia (see abstract). It would have been obvious to one of skill in the art at the time the invention was made that since strokes cause hypoxic-ischemic conditions and resulting injury, treating a stroke with the instantly claimed compound would also treat hypoxia-ischemia occurring due to the stroke. Therefore the invention as a whole is *prima facie* obvious.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-21, 24, 25, and 32 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the treatment of acute neurodegenerative disorders associated with abrupt insult resulting from hypoxia-ischemia selected from cerebrovascular insufficiency, cerebral ischemia and cerebral infarction by administration of the compound of Formula (Ib) S-enantiomer, does not reasonably provide enablement for *prevention* of these acute neurodegenerative disorders. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized in *Ex parte Forman*, 230 USPQ 546 (BPAI 1986) and reiterated by the Court of Appeals in *In re Wands*, 8 USPQ2d 1400 at 1404 (CAFC 1988). The factors to be considered in determining whether undue experimentation is required include: (1) the quantity of experimentation necessary, (2) the amount or direction presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

The Board also stated that although the level of skill in molecular biology is high, the results of such experiments are unpredictable. While all of these factors are considered, a sufficient amount for a *prima facie* case are discussed below.

The nature of the invention & breadth of the claims:

The claims are directed to treatment and prevention of acute neurodegenerative disorders associated with abrupt insult resulting from hypoxia-ischemia selected from cerebrovascular

insufficiency, cerebral ischemia and cerebral infarction by administration of the compound of Formula (Ib) S-enantiomer. Essentially the claims are directed to the prevention of neuronal cell death in the event of an abrupt hypoxic ischemic injury, i.e., prevention of cell death in the event of a transient ischemic stroke.

The relative skill of those in the art:

The relative skill of those in the art is high, generally that of an M.D. and or M.D./Ph.D.

The presence or absence of working examples:

Applicant demonstrates *treatment* of transient cerebral ischemia in the rat MCAO model by administration of by administration of the compound of Formula (Ib) S- enantiomer (the elected compound). See Example 2, pages 20-22, which show significant reduction in infarct volume with administration of the elected species of compound. However, Applicants examples have not demonstrated ***prevention*** of neuronal cell death as a result of treatment. Demonstration of *prevention* of the disease in a mammal would require more extensive evidence to demonstrate possession (See MPEP § 2164.03). It is well established in the courts that "the scope of enablement varies inversely with the degree of unpredictability of the factors involved", and physiological activity is generally considered to be an unpredictable factor, See *In re Fisher*, 166 USPQ 18, at 24 and MPEP § 2164.04.

The state of the prior art & the predictability/unpredictability of the art:

The state of the art regarding the treatment of stroke and the *in vivo* prevention of neuronal death for the treatment of stroke is complex as well as unpredictable. As reviewed by

Cheng et al. ("Neuroprotection for ischemic stroke," *NeuroRx* Jan 2004, Vol. 1, 36-45), there are a wide variety of factors involved in the pathology of stroke and the mechanism of nerve regeneration. Cheng et al. state the following:

> The concept of neuroprotection mainly came from the studies of the pathology and pathophysiology of ischemic brain injury. It has been well documented that abrupt deprivation of oxygen and glucose to neuronal tissues elicits a series of pathological cascades, leading to spread of neuronal death. Of the numerous pathways identified, excessive activation of glutamate receptors, accumulation of intracellular calcium cations, abnormal recruitment of inflammatory cells, excessive production of free radicals, and initiation of pathological apoptosis are believed to play critical roles in ischemic damage, especially in the penumbral zone. (see page 36).

The state of the art regarding treatment of stroke is also very unpredictable, see Table 1 (on page 37) which summarizes a wide variety of clinical trials and the varied (poor) outcomes. Chen et al. even specifically state the "neuroportective benefits from the laboratory bench to the emergency room has not been successful" (p. 36).

Regarding the complexity and unpredictability of ***prevention*** of neuronal death after an abrupt hypoxic ischemic injury, Cheng et al. also discuss neurotrophic factors and neural stem cells (see. p. 39-40). While neurotrophic factors reduced infarct volume and implanted neural stem cells transplanted into the brain resulted in some improvement, in neither case was there demonstration of prevention of the death of these neurons.

The specification does not enable a person skilled in the art to which is pertains to make or use the invention commensurate in scope with the claims. Applicants have failed to provide guidance and information sufficient to allow the skilled artisan to ascertain that the present active agents are effective the prevention of acute neurodegenerative disorders associated with abrupt insult resulting from hypoxia-ischemia selected from cerebrovascular insufficiency, cerebral

ischemia and cerebral infarction by administration of the compound of Formula (Ib) S-enantiomer, in other words, the prevention of injury as a result of transient ischemic stroke. The limited enablement for treatment is noted but does not support a conclusion that transient ischemic stroke injury can be prevented by administration of claimed active agents. Such a result (prevention of neuronal injury) cannot be accomplished with any reasonable certainty or without undue burden of experimentation.

Absent a reasonable *a priori* expectation of success for using the claimed compounds of formula (Ib) S-enantiomer to prevent neuronal injury, the practice of the invention, as it is claimed in its current scope, would require an undue amount of experimentation because the specification provides inadequate guidance to do otherwise.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21, 24, 25, and 32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 and 31-34 of copending Application No. 11/481601. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to the treatment of acute neurodegenerative disorders associated with abrupt insult resulting from hypoxia-ischemia selected from cerebrovascular insufficiency, cerebral ischemia and cerebral infarction by administration of the compound of Formula (Ib) S-enantiomer, in other words, the treatment and prevention of injury as a result of transient ischemic stroke.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy A. Lewis whose telephone number is 571-272-9032. The examiner can normally be reached on Monday-Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amy A. Lewis
/Amy A Lewis/
Examiner, Art Unit 1614

/Ardin Marschel/
Supervisory Patent Examiner, Art Unit 1614